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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/646,416

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Ophir Rachman

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EXAMINER

WANG, RONGFA PHILIP

ART UNIT

PAPER NUMBER

2191

MAIL DATE

DELIVERY MODE

01/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/646,416	Applicant(s) RACHMAN ET AL.	
	Examiner PHILIP WANG	Art Unit 2191	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/16/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-17, 22-30 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18, 31 and 32 is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-17, 22-30, and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Detail Action

1. This office action is in response to RCE filed on 9/16/2008.
2. Per Applicant's request, claims 1-11, 13-17, and 22-33 have been amended.
3. Claims 1-11, 13-17, 22-30, and 33-35 are pending.

Priority

4. The priority date considered for this application is 5/16/2003.

Allowable Subject Matter

5. Claims 18, 31 and 32 are allowable.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-11, 13-17, 22-30, and 33-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Independent claim, claim 1, recites the limitation of "converting a non-streamable installation program...streaming the converted streamable installation program". The examiner interprets "a non-streamable installation program" as a program that, in any case, cannot be converted into a streaming program. Claims 10, 14, and 22 recite similar limitation. The specification does not appear to disclose such limitation. Respective dependent claims of claims 1, 10, 14, and 22 suffer the same deficiency.

Independent claim 8 recites the limitation of "..., wherein the installation program is executable to install a software application..." Upon reviewing the specification, for example, [0008], discloses "The installation program is for use in installing a software application." An installation program that is for use in installing a software application is different from an installation program that actually installs an application program. Further specification, [0044]-[0046], appears to show an installation program/package does not appear need to include an installer. [0044], discloses " Examples of how MSI packages are created will now be described with reference to Figures 6, 7 and 8...."; [0046], "...This single file install assumes the Windows Installer engine already exists and does not need to be included on the disk image."

Therefore, the specification appears to indicate an installer is not in the installation program/package. Referring to Fig. 9A, step 904, where checking of a client's installer is performed. It specifically discloses an installer at client site. What is being streamed is the installation program (or package to be more precise) that is being used by the installer, not the installer itself. Respective dependent claims of claim 8 suffer the same deficiency.

Independent claim 34 recites the limitation of "creating a streamable installation program...that is not configured for application streaming". First of all, an installation program is considered as

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an application that installs an application. When streaming an installation program, it is streaming the installation application program, therefore is considered as application streaming for the installation program. This portion of the claim limitation is already in conflict with itself. As per applicant's argument on page 10 of the remark, "...the files transferred...as being transferred are the actual files to be installed." This argument leads to the interpretation that a streamable installation program is an installation program that actually installs a software application. In one interpretation, an installation program can be interpreted as the installation program as recited in claim 8, i.e., it is executable to install a software application. It is therefore rejected for the same reason for the rejection of claim 8 reasoned above. Further, specification, [0026], last sentence, specifically discloses, "The technique also provides the ability to create an application streaming package...."; [0037], discloses, "...for purpose of application streaming..." It appears the specification does not disclose the limitation of "...not configured for application streaming..." Further more, claim 34 further includes the limitation of "...the streamable installation program is executable...to execute a software application in a streaming mode". This portion of the claim appears to be in conflict with the portion of claim "...not configured for application streaming." Respective dependent claim 35 suffers the same deficiency.

7. Claims 1-7, 10-11, 13-17, 22-26, 29-30, and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claim, claim 1, recites the limitation of "converting a non-streamable installation program...streaming the converted streamable installation program". The examiner interprets "a non-streamable installation program" as a program that, in any case, cannot be converted into a streaming program. Claims 10, 14, and 22 recite similar limitation. The specification does not appear to disclose such limitation that enables persons skilled in the art to practice such invention at time of invention. Respective dependent claims of claims 1, 10, 14, and 22 suffer the same deficiency.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 8-9 and 27-28 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Independent claim 8 recites the limitation of "..., wherein the installation program is executable to install a software application..." Upon reviewing the specification, for example, [0008], discloses "The installation program is for use in installing a software application." An installation program that is for use in installing a software application is different from an installation program that actually installs an application program. Further specification, [0044]-[0046], appears to show an installation program/package does not appear need to include an installer. [0044], discloses " Examples of how MSI packages are created will now be described with reference to Figures 6, 7 and 8...."; [0046], "...This single file install assumes the Windows Installer engine already exists and does not need to be included on the disk image." Therefore, the specification appears to indicate an installer is not in the installation

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program/package. Referring to Fig. 9A, step 904, where checking of a client's installer is performed. It specifically discloses an installer at client site. What is being streamed is the installation program (or package to be more precise) that is being used by the installer, not the installer itself. Respective dependent claims of claim 8 suffer the same deficiency.

No art rejections for the above claims will be provided.

Response to Arguments

9. The examiner wants to bring to the attention of the applicant of the application prosecution history regarding the use of the term "non-streamable". Applicant used the term "non-streamable" in the claims amended on 3/5/2007. The examiner rejected claims including the use of "non-streamable" in the office action mailed on 5/15/2007. A phone interview was conducted on 6/19/2007 regarding the use of "non-streamable" and "streamable" in the claims. An agreement was reached regarding this issue. The applicant has subsequently dropped the use of "non-streamable" in the claims. Applicant now amended the claims to include the same term "non-streamable" in the claims. The examiner is therefore raising the same rejections.

10. Regarding Applicant argument regarding claims 1, 8, 10, 14, 22 and 34 related to converting a non-streamable installation program. Please refer to the detailed rejection in this office action. The applicant is arguing claims that is either not supported by the specification or not enabled.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Wang whose telephone number is 571-272-5934. The examiner can normally be reached on Mon - Fri 8:00AM - 4:00PM. Any inquiry of general nature or relating to the status of this application should be directed to the TC2100 Group receptionist: 571-272-2100.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached on 571-272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip R. Wang/

12/2/2008